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EXAMINER

STOUFFER, KELLY M

ART UNIT

PAPER NUMBER

1792

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 5 September 2008 have been fully considered but they are not persuasive. The applicant argues that the limitation of "without other assistance" has adequate support in the instant disclosure. While the applicant may have provided support for the species that was previously present in the claims "without heat treating the film after exposure to the vapor" the applicant certainly does not indicate that he had possession of the entire genus of "other assistance" at the time of the invention in the instant specification. Further, absence of a positive recitation in the disclosure does not provide reasonable support for a negative limitation in the claims. The applicant certainly has support for using the term without heat treating, but heat treating is not representative of the entire genus of other assistance as claimed and argued. One of ordinary skill in the art could also reasonably read "other assistance" to mean pressure changes, a light or UV induced reaction, it could even be using plasma, etc. all of which these "other assistance" methods are not represented by heating or heat treatment and are not supported by the instant specification. Though annealing without heat treatment may be critical to the instant application and supported by the instant specification, the specification does not make clear that the missing descriptive matter in the way of describing the genus of "other assistance" is present.

The applicant argues that the change of solvent in Furendal is unpredictable and that there is no reasonable expectation of success. However, Furendal discloses in

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column 12 lines 33-50 that the solvent used to anneal the film may be a variety of solvents with a preferred boiling point of 35-120°C. The solvent used to dissolve the polymer in the Examples certainly fits into these boiling points as well. Furendal already broadly includes these solvents in his criteria of useful solvents. Therefore it would have been obvious to use the same solvent to dissolve as well as anneal the polymer, seeing as they fit the same criteria as given by Furendal and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Absent further evidence from the applicant, the applicant has not shown that this would be inoperable and unpredictable. Further, the applicant asserts that Furendal does not teach solvent annealing because Example 16 in Furendal teaches annealing by heat. However, though Furendal may or may not teach an alternate embodiment does not negate that Furendal indeed teaches solvent annealing as discussed above and in previous actions. Therefore, for at least these reasons, the previous rejections of the claims are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY STOUFFER whose telephone number is (571)272-2668. The examiner can normally be reached on Monday - Thursday 7:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner
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kms

/Timothy H Meeks/
Supervisory Patent Examiner, Art Unit 1792